

## **REMARKS**

This Amendment and Response is made in reply to the Office Action mailed December 28, 2009, in which the Examiner:

Rejected claims 1-3, 5, 6, 8, 21, 22 and 25-32 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement; and

Rejected claims 1-3, 5, 6, 8, 21, 22 and 25-32 under 35 U.S.C. § 112, second paragraph, as indefinite.

Applicant respectfully addresses and traverses each of the foregoing rejections below. Claims 1-3, 5, 6, 8, 21, 22 and 25-32 are pending in the subject application. Claims 1 and 25 are independent claims. Claims 1 and 25 have been amended herewith.

### **I. Background**

Applicant gratefully acknowledges and wishes to thank the Examiner for withdrawing the final rejections of claims 1, 5 and 25 under 35 U.S.C. § 102(b) as anticipated by United States Patent No. 5,323,652 to Parker ("Parker"); the final rejections of claims 1-3, 5 and 6 under 35 U.S.C. § 102(e) as anticipated by United States Patent No. 7,048,971 to Arora; and the final rejections of claims 8, 21, 22 and 25-32 under 35 U.S.C. § 103(a) as obvious over United States Patent No. 4,032,687 to Hornsby, Jr., and Parker, based on the arguments set forth in Applicant's Appeal Brief filed August 21, 2009.

### **II. Rejections based on 35 U.S.C. § 112 – Enablement**

Regarding the outstanding rejections of claims 1-3, 5, 6, 8, 21, 22 and 25-32 under 35 U.S.C. § 112, first paragraph, as failing to meet the enablement requirement, the Examiner argues that the claims contain subject matter that was not described in the specification so as to enable one skilled in the art to make and use the claimed inventions. (Office Action, pages 3-4.)

Applicant respectfully disagrees with the Examiner. As is set forth in greater detail below, Applicant submits that the Examiner has failed to follow the established standards set forth in the Manual of Patent Examining Procedure for determining whether a claim is properly enabled, and that the rejections of claims 1-3, 5, 6, 8, 21, 22 and 25-32 must be withdrawn for at least this reason. Moreover, as is also set forth in greater detail below, even if the Examiner had followed the appropriate test for determining whether claims are enabled – specifically, by analyzing the claims with respect to the undue experimentation factors first articulated by the Federal Circuit in *In re Wands*, see M.P.E.P. §§ 2164.01, 2164.01(a) – Applicant submits that his disclosure and the facts made of record in this matter clearly demonstrate that one could practice the claimed inventions without undue experimentation.

Regarding the Examiner's argument that the breadth of the claims is "not with [*sic*] the scope of enablement provided to one skilled in the art by the disclosure," amended claim 1 recites a symbol-bearing receptacle for a fluid comprising a container for the fluid and a transparent symbol disposed on the container, wherein the symbol and the container have different water reactivities, and wherein that difference renders the symbol visually distinct from the container when the container holds the fluid and the temperature of the container is reduced to a condensation point. As is set forth below, Applicant submits that the specification clearly discloses how to make and use each of the elements recited in amended claim 1:

- **Receptacles.** The specification discloses several examples of receptacles in general (including those for storing hydrocarbons, aqueous solutions, water, liquid oxygen, beverages, foodstuffs, automotive products or personal care supplies and cleaning products) along with the particular working examples of industrial tanks and beverage mugs. See, e.g., Application, para. 0004-0007, 0038-0039, 0045-0048; FIGS. 3, 4, 4a, 5-8. Further, the specification discloses many materials from which such receptacles may be made, including metal, plastic, ceramic or glass. See, e.g., Application, para. 0005, 0007.
- **Symbols.** The specification also discloses many examples of symbols, including any known symbol or group of symbols such as

snowflakes, punctuation marks, trademarks or alphabetic letters. See, e.g., Application, para. 0033-0035, 0040-0044; FIGS. 1, 3, 4a, 5, 7. Further, the specification also discloses different materials from which such symbols may be made, including plastics, silicones, metals or films. See Application, paras. 0036, 0041. Additionally, the specification further discloses means or methods for applying symbols to receptacles. Application, para. 0010, 0027-0028, 0030, 0037, 0042, 0048; FIGS. 1-2.

- **Water Reactivities.** The specification discusses the concept of water reactivity, and explains the difference between materials that are, for example, hydrophobic, and those that are, for example, hydrophilic. Application, para. 0031-0032, 0035, 0044-0047. Further, as Applicant noted in his Appeal Brief filed August 21, 2009, and in his Response to Office Action filed January 22, 2009, those of skill in the art are aware of the various water reactivities of materials and their applications, such as coating an industrial tank with a hydrophobic polyurethane mastic, or developing hydrophilic materials from polyester, which is intrinsically hydrophobic. See Appendix A to Response to Office Action filed Jan. 22, 2009. In view of Applicant's disclosure and the facts made of record in this matter, the ability to select materials based on their respective water reactivities was clearly known to those of skill in the art at the time the invention was made.
- **Visual Distinction.** Finally, the specification also discloses how a symbol may become visually distinct when the temperature of the receptacle drops below a condensation point in the environment where the receptacle is located. Application, paras. 0031, 0044; FIG. 4a, 8. For example, the specification discloses how a receptacle comprising a container having a hydrophilic material and a symbol having a hydrophobic material, or vice versa, may render the symbol visually distinct when the container holds a fluid and the temperature is reduced to the condensation point in which the receptacle is situated. See, e.g., Application, paras. 0031-0037; FIG. 4a, 8.

Accordingly, Applicant submits that the scope of the invention recited in amended claim 1 is clearly enabled by Applicant's disclosure and the facts made of record in this matter. For the same or for similar reasons, Applicant submits that the inventions recited in claims 2, 3, 5, 6, 8, 21, 22 and 25-32 are also enabled by Applicant's disclosure and the facts made of record in this matter.

Next, the Examiner argues that the "sticker/label art" is the pertinent art to be considered in determining whether the claims are enabled, and that "the level

of one of ordinary skill in the sticker/label art would does not necessarily have knowledge of advanced chemistry and physics.” Office Action, page 4.

Applicant respectfully disagrees with the Examiner, and submits that the Examiner has improperly limited the pertinent art for the present invention. According to the Manual of Patent Examining Procedure, the pertinent art should be defined in terms of the problem to be solved rather than in terms of the technology area, industry or trade for which the invention is used, and if an invention relates to multiple distinct technologies, a disclosure must be found sufficiently enabling if it enables persons skilled in each art to carry out the aspect of the invention applicable to their specialty. M.P.E.P. §§ 2164.05(a)-2164.05(b). More precisely, where an application relates to multiple arts, the specification must be held sufficiently enabling if it would enable persons skilled in each of the arts, in cooperation with one another, to make and use the claimed invention. M.P.E.P. § 2164.05(b), *quoting Ex Parte Zechnall*, 194 U.S.P.Q. 461 (Bd. Pat. App. Int. 1973) (“appellants’ disclosure must be held sufficient if it would enable a person skilled in the electronic computer art, in cooperation with a person skilled in the fuel injection art, to make and use appellants’ invention”).

The present invention generally relates to fluid receptacles comprising a container and a symbol, wherein the container and the symbol have different water reactivities, and wherein the difference in water reactivities is such that the symbol is visually distinct when a temperature of the container is reduced to a condensation point in an environment in which the container is situated. See, e.g., Application, para. 0012. Therefore, in order to satisfy the enablement requirement, the disclosure must enable a person of ordinary skill in the art of materials science to form a container and a symbol from materials having different water reactivities, and must enable a person skilled in the “sticker/label art” to apply the symbol to the container. Applicant submits that he has clearly met his burden, see, e.g., Application, paras. 0029-0037, and that it was improper for the Examiner to limit her consideration of enablement only to the knowledge and abilities of one of skill in the “sticker/label art.”

Regarding the Examiner's argument that the specification fails to provide any working examples, see Office Action, page 4, Applicant respectfully disagrees with the Examiner. The term "working example," as opposed to a "prophetic example," is based on work that is actually performed. M.P.E.P. § 2164.02. The specification discloses multiple working examples, including an industrial tank and a beer mug, see, e.g., Application, paras. 0038-0049; FIGS. 5-8, of fluid receptacles having a container and a symbol of different water reactivities, wherein the symbol is rendered visually distinct when the container holds a fluid and is reduced to a condensation point. Moreover, even if the specification lacked a working example, such a fact would not be dispositive as to the question of enablement. The specification need not contain an example if the invention is otherwise disclosed in such manner that one skilled in the art will be able to practice it without an undue amount of experimentation. M.P.E.P. § 2164.02, citing *In re Borkowski*, 422 F.2d 904, 908, 164 U.S.P.Q. 642, 645 (C.C.P.A. 1970). Where, as here, the disclosure and the facts of record clearly demonstrate how to make and use a fluid receptacle comprising a container and a symbol, wherein the symbol and the container have different water reactivities, such that this difference renders the symbol visually distinct from the container when the container holds the fluid and the temperature of the container is reduced to a condensation point, Applicant submits that no working example is necessary.

Regarding the Examiner's argument that "[t]he inventor needs to provide what the material is that has the condensation point and what the temperature would be at different atmospheric conditions" and that "[t]he condensation point temperature is dependent upon the material/fluid and pressure," see Office Action, page 4, Applicant respectfully disagrees with the Examiner. The "condensation point" recited in amended claims 1 and 25 depends on the environment in which the container is situated, and not on the material of either the container or the symbol. Rather, amended claims 1 and 25 require that the container and the symbol have different water reactivities, and that the difference

in water reactivities be sufficient to render the symbol visually distinct when a temperature of the container is reduced to a condensation point in the environment. Such recitations relate to structural differences between the container and the symbol, for they relate to the respective material compositions, define “what it is” and not “what it does,” and are not functional.

Moreover, Applicant further submits that it is improper to demand that Applicant disclose each and every temperature and pressure corresponding to every condensation point. The Federal Circuit has repeatedly emphasized that an applicant need only teach one mode of making and using a claimed invention in order to satisfy the enablement requirement, *see Johns Hopkins Univ. v. Cellpro, Inc.*, 152 F.3d 1342, 1361 (Fed. Cir. 1998); *Engel Indus. Inc. v. Lockformer Co.*, 946 F.2d 1528, 1533 (Fed. Cir. 1991), and that a patent applicant need not disclose that which is already known to and available to one of ordinary skill in the art. *Paperless Accounting, Inc. v. Bay Area Rapid Transit Sys.*, 804 F.2d 659, 664 (Fed. Cir. 1986); see also M.P.E.P. § 2164.01 (“[a] patent need not teach, and preferably omits, what is well known in the art”) (collecting Federal Circuit cases). It is well-known that condensation forms when water molecules in relatively warm air come into contact with a relatively cold surface, and tend to form liquid water as the airborne molecules slow down in the vicinity of the cold surface, and this effect will occur in any environment, provided that the temperature of the surface is at or below the condensation point in that environment. The specification clearly explains that when a claimed fluid receptacle is filled with a fluid that is sufficiently cold to reduce the temperature below a condensation point in an environment in which the receptacle is situated, *see* Application, paras, 0031, 0047, FIGS. 4a, 5, 6, or when coolant flow is initiated through a claimed receptacle, such as an industrial tank, such that the temperature of the receptacle drops below a condensation point in an environment in which the receptacle is situated, *see* Application, para. 0044, FIGS. 7-8, the symbol will become visually distinct as condensation forms on the exterior of the claimed receptacles. *See* Application, FIGS. 4a, 5. Accordingly,

Applicant submits that one of skill in the art need not know every temperature and/or pressure corresponding to every environmental condition. Rather, those of skill in the art recognize that the structural nature of the claimed invention – specifically, a container and a symbol having different water reactivities, such that the symbol becomes visually distinct when a temperature of the receptacle is reduced to a condensation point – will become apparent when the temperature of the container is reduced to any condensation point in any environment. If the symbol becomes visually distinct when the temperature of the container is so reduced, then the structure of the fluid receptacle – *i.e.*, the properties of the container and the symbol – satisfies the requirements of amended claim 1. Because the specification and the facts of record clearly enable one of skill in the art to make and use a container and a symbol having different water reactivities, how to reduce the temperature of the container to a condensation point, and how to determine whether the symbol is visually distinct, the disclosure must be deemed properly enabling.

For the foregoing reasons, Applicant submits that claims 1-3, 5, 6, 8, 21, 22 and 25-32 are properly enabled by the disclosure and the facts of record in this matter, and respectfully requests that the rejections thereof must be withdrawn. Additionally, Applicant further submits that the rejections of claims 1-3, 5, 6, 8, 21, 22 and 25-32 under 35 U.S.C. § 112, first paragraph, should be withdrawn for at least the following additional reasons.

First, the Examiner has failed to consider each of the *Wands* factors in rejecting claims 1-3, 5, 6, 8, 21, 22 and 25-32, and the rejections are improper *per se* for at least this reason. “It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the *Wands* factors while ignoring one or more of the others. The examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole.” M.P.E.P. § 2164.01(a), *citing Wands*, 858 F.2d at 737, 740, 8 U.S.P.Q.2d at 1404, 1407 (emphasis added). Although the Examiner bears the initial burden of setting forth a reasonable

explanation as to why she believes that the scope of protection provided by the claim is not adequately enabled by the description of the invention provided in the specification, *see In re Wright*, 999 F.2d 1557, 1562 (Fed. Cir. 1993), by providing evidence or technical reasoning substantiating those doubts, *id.*; *see also* M.P.E.P. § 2164.04, the Examiner has provided no evidence, and at best has offered only her own personal, conclusory opinion, which cannot stand as evidentiary proof. *See In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002). Without a reason to doubt the truth of the statements made in the patent application, the application must be considered enabling. *In re Wright*, 999 F.2d at 1562; *see also In re Marzocchi*, 439 F.2d 220, 223 (C.C.P.A. 1971).

Second, even if each of the *Wands* factors had been properly considered, the rejections of claims 1-3, 5, 6, 8, 21, 22 and 25-32 would still be improper because the Examiner has failed to identify any subject matter that was considered to be enabled. M.P.E.P. § 2164.08 ("If a rejection is made based on the view that the enablement is not commensurate in scope with the claim, the examiner should identify the subject matter that is considered to be enabled."). Moreover, Applicant submits that the prosecution approach taken by the Examiner – *i.e.*, to issue an enablement rejection of claim language in the seventh Office Action on the merits – appears to contravene both the express instructions in the Manual of Patent Examining Procedure for considering claims for enablement, *see* M.P.E.P. § 2164.04 ("the examiner should always look for enabled, allowable subject matter and communicate to applicant what that subject matter is at the earliest point possible in the prosecution of the application," emphasis added), and the Patent & Trademark Office's commitment to compact prosecution. *See* M.P.E.P. § 2106.

Nevertheless, Applicant submits that even if the Examiner had followed the appropriate protocols for reviewing claims for enablement, the disclosure would have been deemed properly enabling. As the Manual of Patent Examining Procedure makes clear, the test for enablement is whether one of skill in the art could make and use the invention based on the disclosure, coupled with



information known in the art, without undue experimentation. M.P.E.P. § 2164.01, *citing Mineral Separation v. Hyde*, 242 U.S. 261, 271 (1916). Whether the level of experimentation is “undue” is determined by resort to the eight factors which were first enunciated by the Federal Circuit in *In re Wands*, 852 F.2d 731, 737 (Fed. Cir. 1988). These factors include (A) the breadth of the claims; (B) the nature of the invention; (C) the state of the prior art; (D) the level of one of ordinary skill; (E) the level of predictability in the art; (F) the amount of direction provided by the inventor; (G) the existence of working examples; and (H) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. M.P.E.P. § 2164.01(a).

As Applicant notes below, each of the *Wands* factors favors a finding that undue experimentation is not required to practice any of the claims, and that the rejections of claims 1-3, 5, 6, 8, 21, 22 and 25-32 should be withdrawn for any of the following reasons.

A. Breadth of the Claims

Applicant submits that independent claims 1 and 25 are neither unduly broad nor all-encompassing. Neither amended claim 1 nor amended claim 25 claims all fluid receptacles comprising both a container and a symbol; rather, the recited container and symbol must have different water reactivities, and the difference between the reactivities must be sufficient to render the symbol visually distinct when the temperature of the receptacle is reduced to a condensation point in the environment. Thus, Applicant submits that amended claims 1 and 25, and the claims depending therefrom, are sufficiently narrow in scope and consistent with the disclosure of the subject Application.

C. State of the Prior Art

Applicant submits that at the time the invention was made, it was within the knowledge of those of skill in the art to fabricate items from select materials based on their respective water reactivities. See, *e.g.*, Appendix A to Response to Office Action filed Jan. 22, 2009. Further, with respect to the particular working example of an industrial tank, see Application, paras. 0038-0044, FIGS.

7-8, it was known that industrial tanks typically have hydrophobic corrosion-resistant coatings. See Appendix A to Response to Office Action filed Jan. 22, 2009. Accordingly, Applicant submits that those of skill in the art could make and use the claimed inventions based on the teachings of the disclosure and the information known in the art at the time the invention was made.

D. Level of Ordinary Skill in the Art

As is set forth above, Applicant submits that the disclosure and the facts made of record demonstrate that those of ordinary skill in the pertinent art are able to select materials based on the respective water reactivity of the materials, see Appendix A to Response to Office Action filed Jan. 22, 2009, and to fabricate components such as containers or symbols from materials having certain water reactivities.

E. Level of Predictability in the Art

Applicant submits that there was no material unpredictability in any pertinent art at the time the invention was made. See M.P.E.P. 2164.03. As is set forth above, those of skill in the art were able to select materials based on their respective water reactivity, and the disclosure sufficiently explains to those of skill in the art not only how to fabricate a container and a symbol having different water reactivities, but also how to affix such a symbol to such a container. See Application, paras. 0030, 0035. The only “unpredictability” in determining whether a receptacle comprising a symbol and a container formed from materials having different water reactivities meets the terms of the claims is whether the symbol becomes visually distinct when a temperature of the receptacle is reduced to the condensation point in an environment in which the receptacle is situated. The disclosure makes clear that this distinction may be determined, for example, by placing an ice-cold beverage in a claimed receptacle at room temperature, or by initiating coolant flow in an industrial tank:

FIG. 4a depicts fluid receptacle assembly 200 after additional of a cold fluid 206 to internal receptacle space 205 of receptacle body 201. The fluid 206 is sufficiently cold to reduce the temperature of receptacle assembly 200 to the condensation point in

the environment where receptacle assembly 200 is situated. This causes the formation of condensation beads 207 on the outer surfaces of receptacle body 201 because of the smooth, hydrophobic surfaces of receptacle body 201.

Application, para. 0031.

Symbols 415 are made visible by passing a coolant through U-tube 408. Because U-tube 408 is confined within chamber 411, relatively little coolant is required quickly to cool the liquid 413 adjacent to the exterior wall of chamber 411. This cools the exterior wall to the condensation point in the environment where industrial tank 101 is situated, and in turn causes the formation of water beads on the outer surface of industrial tank 101 that surrounds symbols 415 as a consequence of the hydrophobic nature of that surface. Symbols 415 become visible because water beads do not form on them as a consequence of their hydrophilic nature.

Application, para. 0044.

F. Amount of Direction Provided by the Inventor

As is set forth above, Applicant has provided more than enough direction to those of skill in the art as to how to make and use the claimed invention. The disclosure explains that the container and the symbol must have different water reactivities. Application, para. 0035 (“[T]he material of which a symbol is fabricated should have a water reactivity that differs from the water reactivity of the fluid receptacle to which the symbol will be affixed. Thus, if a fluid receptacle is fabricated from a hydrophilic material, the symbol should be fabricated from a hydrophobic material. Conversely, if the fluid receptacle is fabricated of a hydrophobic material, the symbol should be fabricated from a hydrophilic material.”). The disclosure further explains how to affix the symbol to the container, see Application, paras. 0030, 0035, and also how to determine whether the difference in the water reactivities renders the symbol visually apparent. See Application, paras. 0031, 0044.

G. Existence of Working Examples

In the Office Action, the Examiner argues that Applicant has failed to provide any working examples. (Office Action, page 4.) Applicant respectfully disagrees with the Examiner. As is set forth above, the specification discloses the particular working examples of an industrial tank and a beverage mug, see, e.g., Application, para. 0004-0007, 0038-0039, 0045-0048; FIGS. 3, 4, 4a, 5-8, which may be made from any appropriate materials, including metal, plastic, ceramic or glass. See, e.g., Application, para. 0005, 0007, 0029 ("Receptacle body 201 is fabricated from smooth, transparent, hydrophobic glass."). As is set forth above, even if the Applicant had failed to provide any such working examples, however, such a fact would not be dispositive as to the question of enablement, see M.P.E.P. § 2164.02, citing *In re Borkowski*, 422 F.2d 904, 908, 164 U.S.P.Q. 642, 645 (C.C.P.A. 1970), because the disclosure and the facts of record clearly enable those of skill in the art to make and use the claimed fluid receptacles.

H. Quantity of Experimentation Needed to Make or Use the Invention Based on the Content of the Disclosure

Applicant submits that a person of skill in the pertinent art would not need to perform an extensive amount of experimentation in order to make and use the invention based on the disclosure. Because the specification clearly enables one of skill in the art to form a container and a symbol from any of the materials of different water reactivities cited in the disclosure, the only "experimentation" required is to reduce the temperature of the receptacle to a condensation point in an environment in which the container is situated is then reached, and to determine whether the difference in water reactivities is such that the symbol appeared to be visually distinct at or below the condensation point.

Even if the level and amount of experimentation would have been extensive, the Federal Circuit has regularly held that such experimentation is not "undue" if the experimentation was routine. *Johns Hopkins Univ. v. Cellpro, Inc.*, 152 F.3d 1342, 1360 (Fed. Cir. 1998); *Ex Parte Kubin*, Appeal No. 2007-0819, App. No. 09/667,859, 83 U.S.P.Q.2d 1410 (Bd. Pat. App. Int. 2007), *aff'd sub*

*nom. In re Kubin*, 561 F.3d 1351 (Fed. Cir. 2009). However, Applicant submits that reducing the temperature of a container after filling it with a fluid – e.g., filling a mug at room temperature with a liquid that is colder than the condensation point, or initiating coolant flow through a tank – could hardly be more routine.

Accordingly, Applicant submits that the Examiner has failed to perform a proper enablement analysis of claims 1-3, 5, 6, 8, 21, 22 and 25-32, and respectfully submits that the rejections of claims 1-3, 5, 6, 8, 21, 22 and 25-32 must be withdrawn for at least this reason. Moreover, even if the Examiner had properly considered the claims for enablement in accordance with the Patent & Trademark Office's established procedures, Applicant submits that no undue experimentation would be necessary in order for those of ordinary skill in the art to make and use the invention, based on Applicant's disclosure and the facts made of record in this matter, and that the rejections of claims 1-3, 5, 6, 8, 21, 22 and 25-32 must be withdrawn for at least this additional reason.

### **III. Rejections based on 35 U.S.C. § 112 – Indefiniteness**

Regarding the outstanding rejections of claims 1-3, 5, 6, 8, 21, 22 and 25-32 under 35 U.S.C. § 112, second paragraph, as indefinite, the Examiner argues that the claims fail to point out and distinctly claim the subject matter regarded as the invention, because they fail to set forth the composition or structure of the container, and only claim properties of the container. (Office Action, page 5.) Applicant respectfully disagrees with the Examiner.

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether those skilled in the art would understand what is claimed when the claim is read in light of the specification. M.P.E.P. § 2173.02, *quoting Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986). Indeed, as the Federal Circuit has repeatedly emphasized, the requirement to “distinctly claim” means that the claim must have a meaning discernible to one of ordinary skill in the art, and only when a claim remains “insolubly ambiguous” without a discernible meaning after all reasonable attempts at construction must it be

declared indefinite. *Id.*, quoting *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1366, 71 U.S.P.Q.2d 1081, 1089 (Fed. Cir. 2004). Definiteness of claim language must be analyzed not in a vacuum but in light of the content of the particular application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. *Id.* In reviewing a claim for definiteness, an examiner must consider the claim as a whole to determine whether the claim appraises one of ordinary skill in the art of its scope and provides clear warning to others as to what constitutes infringement of the patent. *Id.*, citing *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 U.S.P.Q.2d 1279, 1283 (Fed. Cir. 2000).

Applicant submits that those of skill in the art would clearly understand what is claimed in amended claims 1 and 25, and that neither amended claim 1 nor amended claim 25, nor the claims depending therefrom, remains “insolubly ambiguous” in view of the disclosure, the prior art or the interpretation thereof by those of skill in the art. For example, those of skill in the art understand that the invention recited in amended claim 1 clearly requires (a) a receptacle comprising a container and a symbol, (b) the symbol and the container having different water reactivities, and (c) the difference in water reactivities between the container and the symbol must be such that the symbol becomes visually distinct when a temperature of the container is reduced to a condensation point in the environment in which the receptacle is situated. When read in view of the disclosure and the facts made of record in this matter – see, e.g., Application, paras. 0029-0032 (receptacles and/or containers); 0027-0028, 0030, 0032-0035, 0040-0041, 0044-0048 (symbols); 0029, 0031, 0035, 0038 (materials with various water reactivities); and 0031-0032, 0044-0047 (differences in water reactivities rendering the symbol visually distinct), see *a/so* FIGS. 4a, 5, 7, 8; Appendix A to Response to Office Action filed Jan. 22, 2009 – such terms are both clear and distinct, and are not “insolubly ambiguous.”

The Examiner also argues that the term “when a temperature of said container is reduced to a condensation point” is unclear and renders the claim vague and indefinite. See Office Action, page 5. Applicant respectfully disagrees with the Examiner, for the same or for similar reasons set forth above. Nevertheless, to advance the prosecution of the application, Applicant has amended claims 1 and 25 to recite that the difference in water reactivities of the container and the symbol “renders said symbol visually distinct from said container when said container holds said fluid and when a temperature of said container is reduced to a condensation point in an environment where the receptacle is situated.” As the Examiner noted in the Office Action mailed May 16, 2007, “[t]he specification clearly indicates that the symbol is visually distinct when there is a different water reactivities [*sic*] in the materials and when the temperature of the container is reduced to the condensation point.” Accordingly, Applicant submits that any doubt as to the clarity or definiteness of either the recited terms or the scope of the claims has been resolved by the amendments to independent claims 1 and 25.

Finally, regarding the Examiner’s argument that the term “water reactivity” is also unclear, see Office Action, page 6, Applicant again respectfully disagrees with the Examiner, for several reasons. First, as is set forth above, the definiteness of a claim is to be determined not in a vacuum but in light of the content of the particular application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one of skill in the pertinent art at the time the invention was made. The application clearly demonstrates that the term “water reactivity” of a material relates to the affinity of water with the surface. See Application, para. 0031-0032, 0035, 0044, 0047. Furthermore, the specification also discloses, and those of skill in the art will surely understand, that water forms beads on surfaces that are hydrophobic, which is defined as “having little or no affinity for water,” see Dictionary.com, *available at* <http://dictionary.reference.com/browse/hydrophobic> (last viewed June 28, 2010), but does not form beads on surfaces that are hydrophilic, which is defined as

“having a strong affinity for water,” see Dictionary.com, *available at* <http://dictionary.reference.com/browse/hydrophilic> (last viewed June 28, 2010), and that hydrophobic and hydrophilic materials have different water reactivities. See, e.g., Appendix A to Response to Office Action filed Jan. 22, 2009.

Second, as is set forth above, in order for a claim to be deemed indefinite, it must be insolubly ambiguous, and incapable of any construction. As the Federal Circuit has repeatedly noted, “[o]nly claims ‘not amenable to construction’ or ‘insolubly ambiguous’ are indefinite.” See, e.g., *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1347 (Fed. Cir. 2005), citing *Novo Indus., L.P. v. Micro Molds Corp.*, 350 F.3d 1348, 1353 (Fed. Cir. 2003); *Honeywell Int’l, Inc. v. Int’l Trade Comm’n*, 341 F.3d 1332, 1338 (Fed. Cir. 2003).

Applicant notes that the Examiner has not, until this seventh Office Action on the merits, expressed any difficulty in construing the term “water reactivity” in view of Applicant’s disclosure or the facts of record in this matter, and submits that the Examiner must have understood the meaning of the term “water reactivity” in any of the previous Office Actions. Moreover, by waiting until this seventh Office Action on the merits to argue that the term “water reactivity” is indefinite, the Examiner has hereby violated the Patent & Trademark Office’s commitment to compact prosecution. M.P.E.P. § 2106. Furthermore, even if construing the term “water reactivity” was difficult – and Applicant submits that it is not – this fact alone would not permit amended claims 1 and 25 to be rejected for indefiniteness. It is only after reasonable efforts at claim construction prove futile that the claim may be held indefinite. *Datamize, LLC*, 417 F.3d at 1347. Applicant submits that the Examiner’s prior attempts at construing the claims must have been both reasonable and successful because she was able to identify references and formulate rejections of claims which included this term, without indicating any objection as to its definiteness. See M.P.E.P. § 2173.06.

Notably, after a diligent online search, Applicant was unable to identify any case entitled *Ex Parte Slob*, 157 U.S.P.Q. 172, as cited by the Examiner, see Office Action, page 5, or any case standing for the principle that claims which



recite “any conceivable combination of ingredients either presently existing or which might be discovered in the future” are indefinite for this reason. Office Action, page 5. Moreover, Applicant strenuously objects to any suggestion that the claims may not cover future materials which may be developed that have differing water reactivities and thus render a symbol visually distinct after a temperature of the container reaches a condensation point: as the Federal Circuit has held, Applicant need not describe technological developments in the way in which the claimed invention is made that may arise after the patent application is filed. *United States Steel Corp. v. Phillips Petroleum Co.*, 865 F.2d 1247 (Fed. Cir. 1989).

For the foregoing reasons, Applicant respectfully submits that claims 1-3, 5, 6, 8, 21, 22 and 25-32 are neither unclear, vague, indefinite nor “insolubly ambiguous,” and respectfully requests that the rejections thereof be withdrawn.

#### **IV. Conclusion**

Applicant respectfully submits that nothing in the foregoing amendments to claims 1 and 25 constitutes new matter, and that support for these amendments may be found generally throughout the specification as filed, for example, in paragraphs 0031, 0044, 0047.

In view of the foregoing amendments and arguments, Applicant submits that claims 1-3, 5, 6, 8, 21, 22 and 25-32 are presently allowable, and respectfully requests that they be passed to issue.

This Amendment and Response is accompanied by a request for a three (3) month extension of time, and the payment of \$555.00 in extension fees therefor. Applicant believes that no additional fees are due in connection with this Amendment and Response.

Application No. 10/696,373  
Office Action mailed December 28, 2009  
Response to Office Action dated June 28, 2010

Respectfully submitted

/ Gregory W. Gorman /  
Gregory W. Gorman  
473 Wyoming Circle  
Golden, CO 80403  
Tel.: (303) 478-9233  
E-mail: gorman@parkingstripe.com